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Technology Center 2100

In re Application of: John PHENIX
Application No. 10/667,816
Filed: 22 September 2003
For: UTILITY FOR IDENTIFYING
DIFFERENCES BETWEEN TWO JAVA
OBJECTS

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a decision on the petition filed 22 September 2003, under 37 C.F.R. 102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In this case, the petition fails to adequately meet the requirement (e) as set forth supra. Responsive to requirement (e), applicant must provide a “detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.” Petitioner should ensure that the above discussion is directed to *how the language of each of the independent claims are specifically distinguishable and patentable from the references* provided pursuant to requirement (d) supra.

The petition filed 22 September 2003 identifies specifics of the independent claim language (claim 1) and suggests those claim limitations do not appear in the identified reference(s). However, the identified language, i.e. “comparing two objects recursively” and “recording the differences so that the differences may be put into human-readable form” are not set forth in independent claim 1 as alleged. The petition does not specifically recite language or limitations from the independent claim to properly compare/contrast the claimed invention with respect to the prior art in the identified references in accordance with the requirements of 37 CFR 1.111 (b) and (c). Petitioner is required to submit a detailed discussion that includes accurately identified claim limitations with particularity for each independent-claim that shows how the claimed invention distinguishes over the relevant teachings of each reference.

Applicant’s petition further fails to provide a “detailed discussion of the references” with the requisite particularity that illuminates the salient prior art issues relative to the claimed subject matter. Petitioner’s **cursory treatment** of the references does not detail, with the particularity called for under section (e), the relevancy of the prior art pedagogy in order to sufficiently set forth a case distinguishing the limitations claimed to be patentable in relation to the given reference.

In the discussion of the references, Petitioner is required to point out (substantively detail) the prior art elements and associations germane to the claims to fully flesh-out the comparison between the referenced prior art and Applicant’s claimed features. The petition must specifically show, for each independent-claim, specific language that distinguishes over each given reference in order to specify “how the claimed subject matter is patentable over the references.”

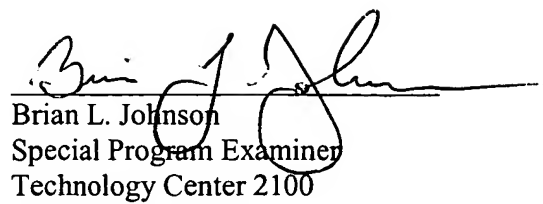
Finally, with reference to the selected seven references cited as “being of possible additional interest (additional references)”, it is unclear to the deciding official if these references are deemed to be “most closely related to the subject matter encompassed by the claims” or not since although cited, no detailed discussion in accordance with the requirements of 37 CFR 1.111(b) and (c) is present. Only those references deemed to be the most closely related to the subject matter encompassed by the claims should be submitted and discussed.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner’s docket to await treatment on the merits in the normal order of examination.

Application SN 10/667,816
Decision on Petition



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